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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,376	10/27/2003	Allen J. Brenneeman	MSE #2650	5779
71331	7590	10/24/2008		
NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601			EXAMINER TURK, NEIL N	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 10/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/694,376

**Applicant(s)**

BRENNEMAN, ALLEN J.

**Examiner**

NEIL TURK

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 22<sup>nd</sup>, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-14 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14 and 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/6/07, 10/27/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Remarks**

This Office Action fully acknowledges Applicant's remarks made on July 22nd, 2008. Claims 1-6, 8-14, and 21-30 are pending. Claims 7 and 15-20 have been cancelled. Claims 28-30 have been newly added. Any objection/rejection not repeated herein has been withdrawn by The Office.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8<sup>th</sup>, 2008 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the open end of the wall structure within at least one of the input and output light guides must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-6, 8-14 and 21-30** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The currently amended

recitation within independent claims 1, 8, and 25 to, "...wherein at least one of said input light guide and said output light guide has a wall structure to assist in guiding light along said optical communication path, said wall structure including an open end and enclosed end, said enclosed end being coupled with said input reflector or said output reflector for forming a portion of said optical communication path..." is regarded as new matter in the claims, as such a recitation does not have basis in Applicant's specification or drawings. The specification does not describe at least one of the input or output light guides having a wall structure that has an open end. Is Applicant attempting to structurally describe the four-sided waveguide structure of the device, as seen in figures 4 and 8, for example?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 1** recites the limitation "said light transmission path". There is insufficient antecedent basis for this limitation in the claim. Does Applicant intend to recite "said optical communication path" so as to coincide with the currently amended language?

**Claims 8-14, 21-27, 29, and 30** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation within independent claims 8 and 25 with respect to the "optical communication path" is unclearly recited. Currently, the claim only recites that the enclosed end is coupled with

the input or output reflector so as to form a portion of the optical communication path. How is this optical communication path structurally or optically defined within the elements of the device? Clarification is required so as to definitely recite the optical communication path and the function of the wall structure to assist in guiding light along an optical communication path (as recited), and not just a portion of the path.

### ***Response to Arguments***

**Applicant's arguments, see pages 8-10, with respect to claims 1, 3-5, 8, 11, 13, 14, 25, and 27 rejected under 35 USC 102(b) as being anticipated by Lemelson** have been fully considered and are persuasive. The rejection of claims 1, 3-5, 8, 11, 13, 14, 25, and 27 has been withdrawn.

Applicant argues that Lemelson fails to disclose or suggest a wall structure to assist in guiding light along said optical communication path, said wall structure including an open end and an enclosed end, said enclosed end being coupled with said input reflector or said output reflector for forming a portion of said optical communication path. While the Examiner agrees that Lemelson does not disclose a wall structure in at least one of the input and output light guides, including an open end and wherein the enclosed end is coupled with either of the input or output reflectors, Examiner notes that such a patentably distinct recitation over the prior art is drawn to the new matter in the claims.

**Applicant's arguments, see pages 9 and 10, filed July 22<sup>nd</sup>, 2008, with respect to claims 1-6, 8-14, and 21-27 rejected over Meserol** alone, as well as the

various combinations, have been fully considered and are persuasive. The rejection of claims 1-6, 8-14, and 21-27 has been withdrawn.

Applicant argues that Meserol fails to disclose or suggest a wall structure to assist in guiding light along said optical communication path, said wall structure including an open end and an enclosed end, said enclosed end being coupled with said input reflector or said output reflector for forming a portion of said optical communication path. While the Examiner agrees that Meserol does not disclose a wall structure in at least one of the input and output light guides, including an open end and wherein the enclosed end is coupled with either of the input or output reflectors, Examiner notes that such a patentably distinct recitation over the prior art is drawn to the new matter in the claims.

Applicant further argues that in Meserol, wall 18 is not coupled with an input reflector or an output reflector, as recited in claim 1. Examiner argues that the enclosed end of wall 18 is coupled to both reflectors 50 and 48 as seen in figure 5, where the reflectors are formed integrally within the wall 18; see, for example, lines 10-21, col. 6.

Newly added dependent claims 28-30 also do not have associated rejections for the same reasons as discussed above, and further their distinct subject matter over the prior art is based on the inclusion of new matter in the currently amended claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL TURK whose telephone number is (571)272-8914. The examiner can normally be reached on M-F, 9-630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797